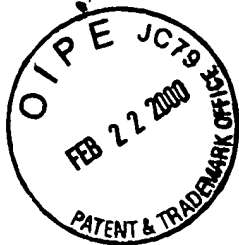


Gp 1642



Docket No. 48012

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: David E. Fisher
Serial No.: 09/229,283 Group No.: 1642
Filed: January 13, 1999 Examiner: S. Ungar
For: USE OF MICROPHTHALMIA FOR DIAGNOSIS, PROGNOSIS,
AND/OR TREATMENT OF MELANOMA

Assistant Commissioner for Patents
Washington, D.C. 20231

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RESTRICTION REQUIREMENT TRANSMITTAL

1. Transmitted herewith is a restriction requirement for this application.

STATUS

2. Applicant is
[] a small entity. A statement:
[] is attached.
[] was already filed.
[X] other than a small entity.

EXTENSION OF TERM

NOTE: "Extension of Time in Patent Cases (Supplement Amendments) — If a timely and complete response has been filed after a Non-Final Office Action, an extension of time is not required to permit filing and/or entry of an additional amendment after expiration of the shortened statutory period.

CERTIFICATE OF MAILING/TRANSMISSION (37 C.F.R. 1.8(a))

I hereby certify that, on the date shown below, this correspondence is being:

MAILING

- X deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231.

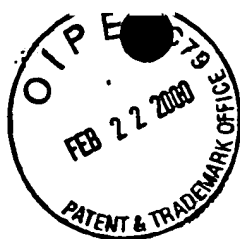
FACSIMILE

- ☐ transmitted by facsimile to the Patent and Trademark Office.

Date: 2/17/2000

Signature

Nicole L. M. Valtz
(type or print name of person certifying)



Gp1642

Docket No.: 41956-DIV

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: David E. Fisher

EXAMINER: S. Ungar

SERIAL NO.: 09/ 229,283

GROUP: 1642

FILED: January 13, 1999

FOR: USE OF MICROPHTHALMIA FOR DIAGNOSIS, PROGNOSIS, AND/OR
TREATMENT OF MELANOMA

The Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

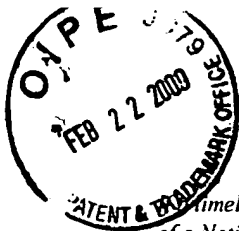
Certificate of Mailing

I hereby certify that the following items are being deposited with the United States
Postal Service with sufficient postage as first class mail in an envelope addressed to
The Commissioner of Patents and Trademark, Washington, DC 20231, on the 17th
day of February, 2000:

1. Transmittal for Restriction Requirement;
2. Restriction Requirement.

Nicole L. M. Valtz

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timely response has been filed after a Final Office Action, an extension of time is required to permit filing and/or entry of a Notice of Appeal or filing and/or entry of an additional amendment after expiration of the shortened statutory period unless the timely-filed response placed the application in condition for allowance. Of course, if a Notice of Appeal has been filed within the shortened statutory period, the period has ceased to run." Notice of December 10, 1985 (1061 O.G. 34-35).

NOTE: See 37 C.F.R. 1.645 for extensions of time in interference proceedings, and 37 C.F.R. 1.550(c) for extensions of time in reexamination proceedings.

3. The proceedings herein are for a patent application and the provisions of 37 C.F.R. 1.136 apply.

(complete (a) or (b), as applicable)

(a) ☐ Applicant petitions for an extension of time under 37 C.F.R. 1.136 (fees: 37 C.F.R. 1.17(a)(1)-(4)) for the total number of months checked below:

	<u>Extension (months)</u>	<u>Fee for other than small entity</u>	<u>Fee for small entity</u>
<input type="checkbox"/>	one month	\$110.00	\$55.00
<input type="checkbox"/>	two months	\$380.00	\$190.00
<input type="checkbox"/>	three months	\$870.00	\$435.00
<input type="checkbox"/>	four months	\$1360.00	\$680.00

Fee: \$ _____

If an additional extension of time is required, please consider this a petition therefor.

(check and complete the next item, if applicable)

☐ An extension for _____ months has already been secured. The fee paid therefor of \$ _____ is deducted from the total fee due for the total months of extension now requested.

Extension fee due with this request \$ _____

OR

(b) ☐ Applicant believes that no extension of term is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition for extension of time.

FEE FOR CLAIMS

4. The fee for claims (37 C.F.R. 1.16(b)-(d)) has been calculated as shown below:

(Col. 1) (Col. 2) (Col. 3) SMALL ENTITY					OTHER THAN A SMALL ENTITY			
Claims Remaining After Amendment		Highest No. Previously Paid For	Present Extra	Rate	Addit. Fee	OR	Rate	Addit. Fee
Total	* Minus	**	=	x \$11 =	\$		x \$22 =	\$
Indep.	* Minus	***	=	x \$41 =	\$		x \$82 =	\$
[] First Presentation of Multiple Dependent Claim				+ \$135 =	\$		+ \$270 =	\$
					Total Addit. Fee	OR	Total Addit. Fee	
					\$ _____		\$ _____	

* If the entry in Col. 1 is less than the entry in Col. 2, write "O" in Col. 3,

** If the "Highest No. Previously Paid For" IN THIS SPACE is less than 20, enter "20".

*** If the "Highest No. Previously Paid For" IN THIS SPACE is less than 3, enter "3".

The "Highest No. Previously Paid For" (Total or Indep.) is the highest number found in the appropriate box in Col. 1 of a prior amendment or the number of claims originally filed.

WARNING: "After final rejection or action (§ 1.113) amendments may be made canceling claims or complying with any requirement of form which has been made." 37 C.F.R. 1.116(a) (emphasis added).

(complete (c) or (d), as applicable)

- (c) [X] No additional fee for claims is required.

OR

- (d) [] Total additional fee for claims required \$ _____.

FEE PAYMENT

5. [] Attached is a check in the sum of \$ _____.
- [] Charge Account No. _____ the sum of \$ _____.
- A duplicate of this transmittal is attached.

FEE DEFICIENCY

NOTE: *If there is a fee deficiency and there is no authorization to charge an account, additional fees are necessary to cover the additional time consumed in making up the original deficiency. If the maximum, six-month period has expired before the deficiency is noted and corrected, the application is held abandoned. In those instances where authorization to charge is included, processing delays are encountered in returning the papers to the PTO Finance Branch in order to apply these charges prior to action on the cases. Authorization to charge the deposit account for any fee deficiency should be checked. See the Notice of April 7, 1986, (1065 O.G. 31-33).*

6. ☒ If any additional extension and/or fee is required, charge Account No. 50-0850.

AND/OR

- ☒ If any additional fee for claims is required, charge Account No. 50-0850.


SIGNATURE OF PRACTITIONER

Reg. No. 30,628

Ronald I. Eisenstein

type or print name of practitioner)

Tel. No. (617) 345-6054

Nixon Peabody LLP

101 Federal Street

P.O. Address

Customer No.

Boston, Massachusetts 02110

BOS 336397.1



Docket No.: 48012

THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: David E. Fisher

EXAMINER: S. Ungar

SERIAL NO.: 09/ 229,283

GROUP: 1642

FILED: January 13, 1999

FOR: USE OF MICROPHTHALMIA FOR DIAGNOSIS, PROGNOSIS
AND/OR TREATMENT OF MELANOMA

RESTRICTION REQUIREMENT

Assistant Commissioner for Patents
Washington, D.C. 20231

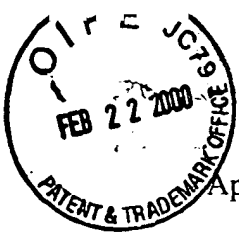
Dear Sir:

In response to the Restriction Requirement of January 18, 2000, applicant elects Group I, claims 1-4 directed to a method for diagnosing melanoma with traverse. Applicant elects as a species, probe the antibody (claim 2).

REMARKS

Although applicant elects Group I, applicant traverses with respect to Group II (claims 5-7 and 11-12). By the Examiner's own admission, **Group I and II** fall into the **same exact search group**. Namely, Class 435, subclasses 4, 6, and 7.1. Thus the search of Group I is coextensive with Group II.

Accordingly, the inventions of Group I and II do not have different classifications and the basis for restriction for examination purposes is not proper under the standard set forth by the Office. Indeed, the Examiner never discussed any differences between Groups I and II, but rather contrasted them with Group III and IV. Thus, applicant respectfully submits that Group I and II should be combined into a single group and examined together.



Applicant reaffirms his species selection of the antibody as a probe for that combined group.

With regard to the Notice to Comply with Requirements for Patent Applications Containing Nucleotide Sequence and/or Amino Acid Sequence Disclosures, applicant is submitting simultaneously herewith the appropriate documents to comply with those requirements (directed to Box Sequence).

Applicant respectfully submits that all claims are in condition for allowance. Early and favorable action is requested.

Date: 2/17/00

A handwritten signature in cursive script, appearing to read "Ronald I. Eisenstein". A long, thin diagonal line extends from the end of the signature towards the upper right corner of the page.

Ronald I. Eisenstein
(Reg. No.: 30,628)
NIXON PEABODY LLP
101 Federal Street
Boston, MA 02110
(617) 345-6054